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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				FERGUSON, MICHAEL P		
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DUANE LANGENWALTER

Appeal 2009-004466
Application 10/797,410
Technology Center 3600

Decided: October 28, 2009

Before: JENNIFER D. BAHR, KEN B. BARRETT, and FRED A.
SILVERBERG, *Administrative Patent Judges.*

BAHR, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Duane Langenwalter (Appellant) appeals under 35 U.S.C. § 134 (2002) from the Examiner's decision rejecting claims 1-16, which are the only claims pending in the application. We have jurisdiction over this appeal under 35 U.S.C. § 6 (2002). Appellant's representative presented oral argument on October 20, 2009.

The Invention

Appellant's claimed invention is directed to a decorative fencing system that includes multiple components that may be assembled in different arrangements. Spec. 1:5-11.

Claim 1, reproduced below, is illustrative of the claimed subject matter.

1. A fencing system comprising:

a plurality of stakes configured to be driven into the ground, each said stake including a hollow stake sleeve having an internal diameter;

a plurality of posts, each said post having a first diameter being smaller than the internal diameter of each said hollow stake sleeve, any one of said posts slidably, interchangeably inserting into and being frictionally and removably retained by any one of said stake sleeves; and

a plurality of structural fencing components, each said fencing component including at least one post attachment collar disposed on an edge thereof, said post attachment collar having an annular opening therethrough, said annular opening having a second diameter larger than said first diameter of each post, any one of said fencing components slidably, pivotally, removably, and

interchangeably attaching to any one of said posts, to thereby connect adjacent structural fencing components to each other while allowing said fencing components to be rotationally adjusted relative to said posts.

The Rejections

Appellant seeks review of the Examiner's rejections of claims 1, 2, and 10 under 35 U.S.C. § 102(b) as being anticipated by Carlson (US 803,741, issued Nov. 7, 1905); claims 11-15 under 35 U.S.C. § 103(a) as being unpatentable over Carlson and Gibbs (US 6,811,145 B2, issued Nov. 2, 2004); claims 1-10 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Ravert (US 1,426,215, issued Aug. 15, 1922) and Carlson; and claims 11-15 under 35 U.S.C. § 103(a) as being unpatentable over Ravert, Carlson, and Gibbs.¹

SUMMARY OF DECISION

We REVERSE.

OPINION

Both of Appellant's independent claims 1 and 16 require (1) at least one stake configured to be driven into the ground and including a stake

¹ Although Appellant does not include this rejection among the grounds of rejection to be reviewed on appeal (*see* App. Br. 5) or present any separate arguments contesting this rejection in the Appeal Brief, Appellant has unambiguously included claims 11-15 in the claims on appeal. Therefore, all pending rejections of these claims are before us for review. Moreover, Appellant does explicitly contest this rejection on page 13 of the Reply Brief.

sleeve, and (2) at least one post slidably inserting into and being frictionally and removably retained by the stake sleeve. In making each of the rejections before us in this appeal, in order to account for these two limitations, the Examiner relies on the anchoring member 5 and post 1 of Carlson. Ans. 3-4 and 7. Appellant argues that Carlson does not disclose, either expressly, or under principles of inherency, that the posts 1 are removably retained by any one of the stake sleeves (anchoring member 5). App. Br. 10-11. The Examiner's position, as articulated, for example, on page 4 of the Answer, is:

Examiner notes that ornament 3 is removably, frictionally received in post 1 as shown [in] cross-sectional view in Figure 5; page 1[,] lines 31-54. In that the cross-sectional view of the engagement between ornament 3 and post 1 is identical to the cross-sectional view of the engagement between post 1 and stake 5, as shown in Figure 2, it is readily apparent that posts 1 are also removably, frictionally received within stakes 5. Clearly, each of posts 1 and each of stakes 5 are identical and post 1 may be interchangeably inserted into any one of stakes 5; Figures 1 and 2.

The Examiner's position is untenable. Carlson discloses that "[e]ach of the posts 1 and 2 is provided with an anchoring member of any desired character, as the parts designated 5 and 6 in Figs. 2 and 3." Carlson 1:42-45. Carlson further discloses that "either form of anchoring members 5 or 6 is attached to the lower end [of the corner-post 7] as may be deemed most efficient and desirable." Carlson 1:51-54. Carlson provides no specific description as to how the anchoring member 5 is attached to the post 1 or corner-post 7. Carlson's Figure 2 merely illustrates the post 1 disposed in a hollow sleeve of the anchoring member 5. Accordingly, we find that

Carlson provides no express description of a post being frictionally and removably retained in the anchoring member 5.

The Examiner's attempt to analogize the cross-sectional view of Carlson's Figure 2 with that of Carlson's Figure 5, which depicts removable ornamental sections 3 (Carlson 1:39) disposed in the upper end of post 1, and to deduce from any similarities between those two figures that posts 1 must likewise be removably and frictionally received within anchoring members 5, amounts to mere speculation and unfounded assumptions. "It is well settled that a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it. Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002) (citations and internal quotation marks omitted). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations and internal quotation marks omitted). As correctly pointed out by Appellant, a removable attachment of the post 1 or corner-post 7 is merely one possibility out of a myriad of other possible attachments. *See* App. Br. 10. Accordingly, we find that a post being frictionally and removably retained in an anchoring member, or stake, is not an inherent feature of Carlson.

For the above reasons, Appellant has demonstrated that the Examiner erred in finding that Carlson discloses a post frictionally and removably retained in a stake. Therefore, we do not sustain the Examiner's rejection of claims 1, 2, and 10 as being anticipated by Carlson.

In rejecting claims 1-16 under 35 U.S.C. § 103(a), the Examiner does not rely on either Gibbs or Ravert for a teaching of a post frictionally and removably retained in a stake. Rather, the Examiner relies on the same unfounded assumption that Carlson teaches this feature. Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions, or hindsight reconstruction to supply deficiencies in the factual basis. *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967). The Examiner also does not articulate any reason why it would have been obvious to modify either Carlson or Ravert to provide such a feature. Accordingly, the Examiner has not established a *prima facie* case of obviousness of any of claims 1-16. See *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (rejections on obviousness grounds must be supported by “some articulated reasoning with some rational underpinning” to combine the known elements in the manner required in the claim at issue). Therefore, we do not sustain the rejections of claims 11-15 as being unpatentable over Carlson and Gibbs; claims 1-10 and 16 as being unpatentable over Ravert and Carlson; and claims 11-15 under 35 U.S.C. § 103(a) as being unpatentable over Ravert, Carlson, and Gibbs.

DECISION

The Examiner’s decision is reversed.

REVERSED

Appeal 2009-004466
Application 10/797,410

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413